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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,747	04/25/2001	Louis Bouchard	AVALUC-01800	7367
28960 7590 07/17/2008 HAVERSTOCK & OWENS LLP 162 N WOLFE ROAD SUNNYVALE, CA 94086				
EXAMINER PHILLIPS, HASSAN A				
ART UNIT 2151		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/842,747

Applicant(s)

BOUCHARD, LOUIS

Examiner

HASSAN PHILLIPS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to communications filed May 15, 2008.

Response to Arguments

2. Applicant's arguments filed May 15, 2008 have been fully considered but they are not persuasive. Applicant argued:

- a) "Smith does not teach that the network services provider sends a cumulative mailbox content list that comprises a list of stored messages" as claimed in independent claim 1, and similarly recited in independent claims 7, 14, and 19; and,
- b) "Cloutier in view of Stein does not teach a mailbox content list including messages with multiple different message formats" as claimed in independent claims 1, 7, 14, and 19.

Examiner respectfully disagrees with applicant's assertions.

3. With regards to a), applicant's independent claim 1 recites "wherein the updated mailbox content list comprises a list of stored messages with multiple different message formats" and "transmitting the updated mailbox content list from the server to the wireless device". In giving broadest reasonable interpretation to the claimed invention, examiner interpreted the updated mailbox content list, as each notification message transmitted from the SMS server (5300) to the wireless device (1100). Clearly in the teachings of Smith, each notification message may comprise of multiple different

message formats, (see Smith, col. 7, lines 15-24, and col. 7, line 51-col. 8, line 10).

Furthermore, nowhere in applicant's claimed invention is a cumulative mailbox content list recited. Accordingly, applicant's claimed invention fails to distinguish from the interpretation given to the claims by the examiner.

4. With regards to b), as indicated in the previous action, examiner maintains it would have been obvious to one of ordinary skill in the art to modify the teachings of Cloutier in view of Stein to teach a mailbox content list including messages with multiple different message formats. In response to applicant's argument that it must be the teachings of Stein to which the examiner must direct the rejection, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Cloutier clearly teaches a system to provide a message alert from a server (120) to a wireless device (170), the system directed to e-mail, voice mail, facsimile, etc. (see abstract, also see Fig. 1). Given the analogous teachings of Stein, one of ordinary skill in the art would have found it obvious to modify the teachings of Cloutier with Stein to show the message alert being a mailbox content list so that a user would be provided the flexibility to select which message the

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user desired to receive, in cases where multiple messages were available for the user, (see Stein, col. 3, lines 24-32).

5. Accordingly the references supplied by the examiner in the previous office action covers the claimed limitations. The rejections are thus sustained. Applicant is requested to review the prior art of record for further consideration.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 2, 4-7, 9-14, 16-20, 22-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al. (hereinafter Smith), U.S. Patent 6,33,973 (previously made of record and not relied upon).

8. In considering claims 1, 7, 14, and 19, Smith teaches a system and method of utilizing a push model to provide access to a message list in one or more of a voice, a

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fax, an e-mail and a unified mailbox through a wireless network, the method comprising the steps of:

a. determining if an updated mailbox content list is to be transmitted by a server (5300) to a wireless device (1100), wherein the server independently determines if and when to transmit the updated mailbox content list, further wherein the updated mailbox content list comprises a list of stored messages with multiple different message formats, (col. 7, lines 15-24, and col. 7, line 51-col. 8, line 10);

b. forming a first communication link through a wireless network (1800) between the server and the wireless device, (col. 7, lines 15-24, and col. 7, line 51-col. 8, line 10);

c. transmitting the updated mailbox content list from the server to the wireless device over the first communication link, (col. 7, lines 15-24, and col. 7, line 51-col. 8, line 10);

d. automatically receiving the updated mailbox content list by the wireless device from the server through the first communication link, (col. 7, lines 15-24, and col. 7, line 51-col. 8, line 10);

e. disconnecting the first communication link after the wireless device receives the updated mailbox content list, (col. 7, lines 15-24, and col. 7, line 51-col. 8, line 10);

f. scrolling through the updated mailbox content list and selecting a message therefrom with the wireless device, (col. 8, lines 26-45, also see col. 9, lines 54-60 and col. 10, lines 17-30 and lines 47-56);

g. forming a second communication link through the wireless network thereby linking the wireless device and the server, (col. 9, lines 54-60 and col. 10, lines 17-30 and lines 47-56);

h. selectively receiving the message on the wireless device from the server over the second communication link, (col. 9, lines 54-60 and col. 10, lines 17-30 and lines 47-56);

i. providing the message to a user of the wireless device, (col. 9, lines 54-60 and col. 10, lines 17-30 and lines 47-56).

9. In considering claims 2, 9, and 20, Smith teaches a new message notification, including the updated content list, (col. 8, lines 26-45 and col. 8, line 66-col. 9, line 5).

10. In considering claims 4, 16, and 22, Smith teaches scrolling through the updated mailbox content list without accessing the wireless network, (col. 8, lines 26-45, also see col. 9, lines 54-60 and col. 10, lines 17-30 and lines 47-56).

11. In considering claims 5, 17, and 23, Smith further teaches the user issuing a command using the wireless device, (col. 8, lines 26-45, also see col. 9, lines 54-60 and col. 10, lines 17-30 and lines 47-56).

12. In considering claims 6, 18, and 24, Smith further teaches the server playing the message according to a command given by the user, (col. 8, lines 26-45, also see col. 9, lines 54-60 and col. 10, lines 17-30 and lines 47-56).

13. In considering claim 10, Smith teaches after being sent by the server, the new message notification and the updated content list can be viewed by a user with the wireless device, (col. 8, lines 26-45).

14. In considering claim 11, Smith teaches the user may scroll through the updated mailbox content list with the wireless device, (col. 8, lines 26-45).

15. In considering claim 12, Smith further teaches a user selecting a message by issuing a command to the server, (col. 9, lines 54-60 and col. 10, lines 17-30 and lines 47-56).

16. In considering claim 13, Smith further teaches the server delivering the message selected by the user and the message is played for the user by the wireless device, (col. 9, lines 54-60 and col. 10, lines 17-30 and lines 47-56).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 1, 2, 4-7, 9-14, 16-20, 22, 24, are rejected under 35 U.S.C. 103(a) as being unpatentable over Cloutier, in view of Stein et al (hereinafter Stein), U.S. Patent 6,289,212 (supplied by Applicant).

19. In considering claims 1, 7, 14, and 19, Cloutier teaches a method and system for utilizing a push model to provide access to messages in one or more of a voice, a fax, an e-mail and a unified mailbox through a wireless network, the method comprising the steps of:

- a. determining if a message alert is to be transmitted by a server (120) to a wireless device (170), wherein the server independently determines if and when to transmit the message alert, further wherein the message alert is associated with multiple different message formats, (col. 2, lines 30-49, col. 3, line 62-col. 4, line 14, col. 8, lines 11-21, also see Fig. 1);
- b. forming a first communication link through a wireless network between the server and the wireless device, (col. 2, lines 30-41, col. 3, line 62-col. 4, line 14, also see Fig. 1);
- c. transmitting the message alert from the server to the wireless device over the first communication link, (col. 2, lines 30-41, col. 3, line 62-col. 4, line 14, also see Fig. 1);

d. automatically receiving the message alert by the wireless device from the server through the first communication link, (col. 2, lines 30-41, col. 3, line 62-col. 4, line 14, also see Fig. 1);

e. disconnecting the first communication link after the wireless device receives the updated mailbox content list, (col. 2, lines 30-41, col. 3, line 62-col. 4, line 14, also see Fig. 1);

f. viewing the alert on the wireless device, (col. 2, lines 30-41, col. 3, line 62-col. 4, line 14, also see Fig. 1);

g. forming a second communication link through the wireless network thereby linking the wireless device and the server for receiving a message, (col. 2, lines 41-45);

h. and providing the message to the user, (col. 2, lines 41-45).

Although the method of Cloutier shows substantial features of the claimed invention, it fails to explicitly disclose: the message alert being a mailbox content list; selecting a message with the wireless device; and receiving the message over a wireless network.

Nevertheless, in a similar field of endeavor, Stein teaches a method for providing electronic mail services during network unavailability comprising: receiving a mailbox content list from a server over a wireless network, (col. 3, lines 8-39); scrolling through the mailbox content list with a wireless device, (col. 3, lines 8-39); and selecting a message with the wireless device, (col. 3, lines 8-39).

Thus given the teachings of Stein, it would have been obvious to one of ordinary skill in the art to modify the teachings of Cloutier to show the message alert being a mailbox content list that a user could scroll through on a wireless device in order to select a message to be received over the wireless network. This would have provided the user the flexibility to select which message the user desired to receive, in the case that multiple messages were available for the user on the server, (Stein, col. 3, lines 24-32).

20. In considering claims 2, 9, and 20, Cloutier teaches a new message notification. See col. 2, lines 30-41.

21. In considering claims 4, 16, and 22, Cloutier teaches viewing the alert without accessing the wireless network. See col. 2, lines 30-41.

22. In considering claims 5, 17, and 23, Cloutier further teaches the user issuing a command using the wireless device. See col. 6, lines 50-54.

23. In considering claims 6, 18, and 24, Cloutier further teaches the server playing the message according to a command given by the user. See col. 6, lines 54-61.

24. In considering claim 10, the system of Cloutier provides a means for viewing a new message notification and an updated content list by a user with the wireless device. See col. 2, lines 30-41.

25. In considering claim 11, although the system of Cloutier shows substantial features of the claimed invention, it fails to explicitly disclose: a) Scrolling through a mailbox content list.

Nevertheless, in a similar field of endeavor, Stein teaches a method for providing electronic mail services during network unavailability comprising: a) Scrolling through a mailbox content list with a wireless device, (col. 3, lines 24-39).

Thus given the teachings of Stein, it would have been obvious to one of ordinary skill in the art to modify the teachings of Cloutier to show scrolling through an updated mailbox content list with the wireless device. This would have provided the user the flexibility to select which message the user desired to receive, in the case that multiple messages were available for the user on the server along with the new message, Stein, col. 3, lines 24-32. 15.

26. In considering claim 12, Cloutier further teaches a user selecting a message by issuing a command to the server. See col. 6, lines 50-54.

27. In considering claim 13, Cloutier further teaches the server delivering the message selected by the user and the message being played for the user by the wireless device. See col. 6, lines 54-61.

28. Claims 3, 8, 21, are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of the Applicants Admitted Prior Art (AAPA).

29. In considering claims 3, 8, and 21, Smith discloses a wireless network (1800) used for SMS communications, (col. 7, lines 15-24).

Although the disclosed teachings of Smith show substantial features of the claimed invention, they fail to expressly disclose the wireless network having a low data-bandwidth, and a high-data latency.

Nevertheless, it was well known in the art at the time of the present invention for wireless networks (in particular SMS networks) to have a low data-bandwidth, and a high-data latency. This was admitted by the applicant in the specification on page 1, line 33, and page 2, lines 1-5.

Thus, given the teachings of the AAPA it would have been obvious to one of ordinary skill in the art to modify the teachings of Smith to show the wireless network having a low data-bandwidth, and a high-data latency. This would have advantageously utilized the wireless network disclosed by Smith in a fashion well known to those of ordinary skill in the art at the time of applicant's invention.

30. Claims 3, 8, 21, are rejected under 35 U.S.C. 103(a) as being unpatentable over Cloutier, in view of Stein, and further in view of the Applicants Admitted Prior Art (AAPA).

31. In considering claims 3, 8, and 21, although the combined methods of Cloutier and Stein show substantial features of the claimed invention, they fail to expressly disclose the wireless network having a low data-bandwidth, and a high-data latency.

Nevertheless, it was well known in the art at the time of the present invention for wireless networks to have a low data-bandwidth, and a high-data latency. This was admitted by the applicant in the specification on page 1, line 33, and page 2, lines 1-5.

Thus, given the teachings of the AAPA it would have been obvious to one of ordinary skill in the art to modify the teachings of Cloutier and Stein to show the wireless network having a low data-bandwidth, and a high-data latency. This would have shown that the methods of Cloutier and Stein work in networks that were well known at the time of the present invention such as wireless networks with low data-bandwidth, and high-data latency.

32. Claim 15, is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Parsons et al. (hereinafter Parsons), U.S. Patent Pub. No. 2002/0087643.

33. In considering claim 15, although the disclosed teachings of Smith show substantial features of the claimed invention, they fail to expressly disclose transmitting a new updated mailbox content list to the wireless device after a user accesses the message list using means other than the wireless device.

Nevertheless, in analogous teachings, Parsons discloses transmitting a new updated mailbox content list to a wireless device (i.e. 118) after a user accesses the message list using means other than the wireless device (i.e. the user accessed the message list using a desktop or remote email client application; see pg. 3, par. 0030, also see pg. 5, par.'s 0041, 0042, and Fig. 1).

Thus, given the teachings of Parsons, it would have been obvious to one of ordinary skill in the art to modify the teachings of Smith to show transmitting a new updated mailbox content list to the wireless device after a user accesses the message list using means other than the wireless device. This would have advantageously provided the user of the wireless device with the most up to date mailbox content list with regards to new messages, or messages that have been read, deleted, listened to, etc., (see Parsons, pg. 5, par.'s 0041, 0042) .

34. Claim 15, is rejected under 35 U.S.C.I 103(a) as being unpatentable over Cloutier, in view of Stein, and further in view of Parsons.

35. In considering claim 15, although the combined methods of Cloutier and Stein show substantial features of the claimed invention, they fail to expressly disclose

transmitting a new updated mailbox content list to the wireless device after a user accesses the message list using means other than the wireless device.

Nevertheless, in analogous teachings, Parsons discloses transmitting a new updated mailbox content list to a wireless device (i.e. 118) after a user accesses the message list using means other than the wireless device (i.e. the user accessed the message list using a desktop or remote email client application; see pg. 3, par. 0030, also see pg. 5, par.'s 0041, 0042, and Fig. 1).

Thus, given the teachings of Parsons, it would have been obvious to one of ordinary skill in the art to further modify the teachings of Cloutier in view of Stein to show transmitting a new updated mailbox content list to the wireless device after a user accesses the message list using means other than the wireless device. This would have advantageously provided the user of the wireless device with the most up to date mailbox content list with regards to new messages, or messages that have been read, deleted, listened to, etc., (see Parsons, pg. 5, par.'s 0041, 0042).

Conclusion

36. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HASSAN PHILLIPS whose telephone number is (571)272-3940. The examiner can normally be reached on Mon-Fri (8am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Hassan Phillips
Examiner, Art Unit 2151
/John Follansbee/
Supervisory Patent Examiner, Art Unit 2151